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EXAMINER

PATEL, JAGDISH

ART UNIT PAPER NUMBER

3624

DATE MAILED: 10/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/531,571

Applicant(s)

WILLIAMS ET AL.

Examiner

JAGDISH N PATEL

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-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

Claim Objections

1. Claim 29 is objected to because of the following informalities: steps (g) and (h) recites "electronic account database" which should properly recited as "electronic billing account database" to form a proper antecedent basis in the claim. Appropriate correction is required.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 11-16 and 25-31 are rejected under 35

U.S.C. 101 because the disclosed invention is inoperative and therefore lacks utility. Exemplary claim 11 recites a system having a plurality of elements, each in the form of computer executable codes (an update file, a search application etc.) which are capable of interacting with each other. However, the system is rendered non-functional and inoperative because there is nothing in the claimed system to impart functionality of these computer codes. Note that functionality of the computer executable codes is realized only, when they are acted upon by a processor or a computing device.

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This deficiency is also present in each of the dependent claims 12-16.

Claims 25-31 are similarly analyzed.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim recites that the update file, the search application, the format application and the communication application are "provisioned with a merchant". However, it is noted that the recited elements are electronic components such as computer software codes, which may not be properly associated with a human entity such as a merchant. This deficiency renders claim 14 indefinite and rendered indistinguishable from the parent claim.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claim 11 and 25-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Northington (US Pat. 6,128,602).

Claim 11. A system for notifying an electronic billing vendor of customer status changes comprising:

(a) an update file adapted to store service order activities; (data repository element 102, see Fig. 1 and col. 5 L 7-15)

(b) a search application in communication with the update file, wherein the search application searches the service order activities for entries that correspond both to customers of the electronic billing vendor and to service order activities that affect account numbers; (application services element 103, see Fig. 1 and col. 5 L 7-15 and col. 7 L 46-51);

(c) a format application in communication with the search application, wherein the format application places the entries in a format compatible with the electronic billing vendor;

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(col. 8 L 13-18, Report Generator 401, .. depending on the request, the report generator may either format the data for display to the user via the Web services element or provide the report to the database repository element 102 for storage and later retrieval.)

(d) a communication application in communication with the format application, wherein the communication application transmits the entries through a network to the electronic billing vendor.

(Navigator 404, col. 8 L 41-end, electronic billing vendor is represented by customer service terminal 120).

Claim 25. Northington, discloses an application for notifying an electronic billing vendor (entities served by the accounting system disclosed) of customer status changes comprising:

(a) a file of service order activities;

(Fig. 1 data repository services element 102)

(b) a search function that searches the service order activities for entries corresponding both to electronic billing customers and account changes that affect account numbers; (Fig. 4 col. 7 L 45-51 provides details of application services element 103 which include a data processor for processing incoming transaction data and report generator 401..in response to a command received from a user.. Note that since the application services element generates reports specific to the user a search function must be associated with it to extract account specific data from the database)

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(c) a format function that translates the entries from a first record format to a second record format;

(col. 7 L 5-27, in response the data network mover 203 formats the files for transfer to external systems..)

and

(d) a communication function that transmits the entries to the electronic billing vendor.

(col. 7 L 23-27, ..in response, the data network mover..transmits the formatted files to SNA gateways 202 for transfer to the external systems.)

Claim 26. wherein the file provides indicators for service order activities corresponding to electronic billing customers and provides indicators for service order activities corresponding to account changes that affect account numbers, and wherein the search function searches for the indicators.

(col. 9 L 49- col. 10 L 5, .. Authorized end users may perform maintenance on an account such as address changes, spending control changes, account hierarchy, account status (e.g., open or closed)...).

Claim 27. The application of claim 25, wherein the first record format is compatible with the file and the

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second record format is compatible with the electronic billing vendor.

(col. 7 L 5-27, in response the data network mover 203 formats the files for transfer to external systems..)

Claim 28. The application of claim 25, wherein the communication application uses file transfer protocol over a network.

(col. 6 L 52- end he SNA gateways 202 may be configured using network gateway protocols as may be known in the art, and the information necessary to identify the receiving system and to complete data transfers with the receiving system is configured based upon the protocols used by the systems 106, 112, and 130)

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-10, 12-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Northington and further in view of Rigole US 2001/0049632A1 (Rigole).

Claim 1: Northington discloses transmitting (reporting) entries that indicate account changes to an

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electronic billing vendor (col. 16 -18, refer in particular to Report titled "Account Change").

Northington, fails to disclose that entries that the transmitted entries that indicate account changes to the electronic billing vendor are based upon method steps (a) flagging entries, in an update file..(b) searching the update file for the flagged entries and (c) reformatting the flagged entries.

Rigole, in the same field endeavor discloses, a method for notifying an entity of customer status changes which incorporate these steps. Rigole teaches the aforementioned steps of flagging entries, in an update file..., searching the update file for the flagged entries and reformatting the flagged entries in order generate a reformatted flagged entries. (Refer to paragraph [0048], ..application data is captured and logged into a server log. ..and may reassign an identifier or key value to the data. ..the identifier could be an indicator of any number of things ..the logged data may then be parsed..that assign items of the raw data into predefined fields in a database..., alternatively or simultaneously, the data may be directed by a script or other program into a program module for processing the data).

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It would have been obvious to one of ordinary skill in the art at the time of invention to implement the aforementioned steps in Northington method of transmitting (reporting) entries that indicate account changes to a electronic billing vendor because it would permit the reporting entity (such as the client of the billing vendor) to communicate the account change data for consolidation, monitoring and control of the client's accounts.

Claim 2: update file stores one entry for each service order activity (COL. 15 l 38-45, financial transaction and account data maintained by the system 100 in data repository element 102 may include various account fields, depending on the needs of the entity and the requirements of the industry. For example, financial transaction data fields may include: ..).

Claims 3-5: entries are placed in the update file at an interval, searching the update file looks first..and second for..among the flagged entries (this limitations recite steps routinely selected by programmers to manage database records). It would have been obvious to one of ordinary skill in the art at the time of invention to implement the aforementioned steps in the recited prior art

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because it would improve efficiency of search and optimize effort.

Claims 6-8 : wherein reformatting the flagged entries that indicate account changes translates the flagged entries that indicate account changes into a record format required by the electronic billing vendor, ..the record format includes data selected from a the group consisting essentially of date of activity, customer contact information, old account number, new account number, and action, ..the action is an activity selected from the group consisting essentially of delete, change, and activate.

(refer to col. 16 L 45-51, in a preferred embodiment of the present invention, reports generated by report generator 401 within application services element 103 may be formatted in numerous formats, including selected information of interest to the recipient of the report. Refer to table for various report activities presented in the Table., also refer to col. 9 L 49-66, ..account changes)

Claim 9. The method of claim 1, wherein transmitting the flagged entries that indicate account changes to the

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electronic billing vendor occurs through a network using file transfer protocol.

(Col. 5 L 48-51, Remote terminal 110 may access the system 100 using, for example, browser software technology or other electronic accessing methods as may be known to one of skill in the art.)

Claim 10. The method of claim 1, wherein the account changes are selected from the group consisting essentially of an account termination and an account number change.

(Refer to Table in col. 16, Report titled "Account Change Report" and col. 9 L 64-66.)

Claims 12. and 13. Refer to claims 7 and 8 analysis.

Claim 14. Northington fails to teach that the update file, the search application, the format application, and the communication application are provisioned with a merchant.

However, it is noted that mere locating the files at a different physical location does not change the composition or the functionality of the system. In this regard, the claim fails to further limit the parent claim and merits no further analysis.

Claim 15. Northington fails to teach that the search application, the format application, and the communication

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application are a single application. It would have been obvious to one of ordinary skill in the art at the time of the invention to the search application, the format application, and the communication application are a single application as disclosed by Northington into a single application since it has been held that rearranging parts of an invention involves only routine skill in the art. In re Japiske, 86 USPQ 70.

Claim 16. Northington doesn't expressly show that the update file is generated by a customer billing system and is transmitted from the customer billing system to a customer information database. However these differences are only found in the *nonfunctional descriptive material* and are not *functionally* involved in the system for notifying as claimed. Thus, this *descriptive material* will not distinguish the claimed invention from the prior art in terms of patentability see In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the update file as per claim 16 because

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such inclusion of the update file would not alter the scope of the system as claimed.

Claim 17: Northington discloses a method for notifying an electronic billing vendor of customer status changes comprises:

(a) changing customer services (col. 9 L 64-67 authorized end users may perform maintenance on an account such as address changes, spending control changes, account hierarchy, account status (e.g., open or closed);

(b) recording the changed services in a customer billing system (customer billing system corresponds to system 100 of Northington where the changes in the services are recorded);

(d) downloading a period of the changed services to an update file (col. 12 L 59-64, According to an alternate preferred embodiment of the method of the present invention (not shown), navigator 404 is programmed to automatically initiate a polling operation of the financial systems 106 and 112 periodically, for example, hourly or daily, to update the data stored by system 100 in database repository element 102 and col. 8 L 1-7 reports may be provided ..periodically);

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(f) copying the flagged changed services that affect account numbers in to a notification file (refer to reports as discussed in limitation (d), also refer to col. 16 L 46-55, reports generated by the report generator 401);

(g) formatting the notification file in to a format used by the electronic vendor (col. 16 L 45-55 reports generated by application services element 103 may be formatted in numerous formats, including selected information of interest to the recipient of the report. Examples of reports generated by report generator 401

may include: ..);

(h) making the formatted notification file available to the ..vendor (refer to step (g) analysis).

Northington, fails to disclose, at least explicitly the steps (c) flagging changed services..(e) searching the update file for the flagged changed services.

Rigole, in the same field endeavor discloses, a method for notifying an entity of customer status changes which incorporate these steps. Rigole teaches the aforementioned steps of flagging changed services, in an update file...,searching the update file for the flagged entries and reformatting the flagged entries in order generate a reformatted flagged entries. (Refer to paragraph [0048],

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..application data is captured and logged into a server log. ..and may reassign an identifier or key value to the data. ..the identifier could be an indicator of any number of things ..the logged data may then be parsed..that assign items of the raw data into predefined fields in a database.., alternatively or simultaneously, the data may be directed by a script or other program into a program module for processing the data).

It would have been obvious to one of ordinary skill in the art at the time of invention to implement the aforementioned steps in Northington method of transmitting (reporting) entries that indicate account changes to a electronic billing vendor because it would permit the reporting entity (such as the client of the billing vendor) to communicate the account change data for consolidation, monitoring and control of the client's accounts.

Claim 18. Analyzed as per claim 7.

Claim 19. Analyzed as per claim 8.

Claim 20. wherein the period is daily (col. 8 L 1-7, reports may be provided in accordance with pre-programmed criteria).

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Claim 21. wherein making the notification file available comprises transmitting the notification file through a network.

(Northington, col. 5 L 16-25, refer to communication network 105)

Claim 22. The method of claim 21, wherein the network is the Internet and the notification file is transmitted through a firewall.

(Northington, col. 3 refer to description of the open architecture system having a "web services element")

Claims 23 and 24: analyzed per claims 3-5 analysis.

Claim 32: Please refer to analysis of claim 1 for steps (a) - (d).

Steps (e) - (f) are disclosed by Northington at col. 9 line 49 - col. 10 L 37. Note that steps (e)-(g) are indicated as being performed by "end-users". Steps (e) reading account numbers associated with flagged entries (f) matching the account numbers and (g) updating the electronic billing account numbers are inherently indicated as "authorized end-users..perform maintenance on an account..".

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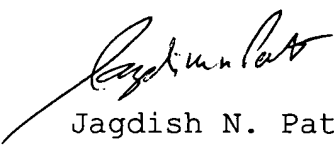
Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jagdish Patel whose telephone number is (703) 308-7837. The examiner can normally be reached Monday-Thursday from 8:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin, can be reached at (703) 308-1038. The fax number for Formal or Official faxes to Technology Center 3600 is (703) 305-7687. **Draft faxes may be submitted directly to the examiner at (703) 746-5563.**

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113 or 308-1114. Address for hand delivery is 2451 Crystal Drive, Crystal Park 5, 7th Floor, Alexandria VA 22202.


Jagdish N. Patel
(Examiner, AU 3624)

9/29/03